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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,927	01/14/2002	Ulrich Schubert	151.2-US-WO	5585

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EXAMINER

MOSHER, MARY

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 03/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/913,927

Applicant(s)
Schubert et al

Examiner
Mary Mosher

Art Unit
1648



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/20/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-33 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: **Sequence notice**

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DETAILED ACTION

Sequence Rules

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Compliance is required. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Response to Amendment

The preliminary amendment filed 20 August 2001 is objected to under ~~35 U.S.C. 132~~

because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment adding Examples 16-22 to the specification. Support for the experimental details set forth in the amendment is not apparent in the original specification or figures. Also, the inventor's oath refers to the PCT application as filed on Feb 19, 2000, and does not refer to any amendments. For both these reasons, the amendment to the specification is seen as new matter.

Applicant is required to cancel the new matter in the reply to this Office action.

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Claim Objections

Claims 32 and 33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 31 requires a peptide "comprising a regulatory virus protein R (Vpr)". Claim 31 therefore requires the peptide to include an entire Vpr protein. However, claims 32 and 33 are drawn to peptides which include less than the entire Vpr protein. Therefore these claims expand, rather than limit, the scope of the parent claim, since they encompass peptides that do not comprise an entire Vpr protein.

Claim Rejections - 35 USC § 112

Claims 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32 and 33 use the terminology "sVpr", and it is not clear what the "s" is intended to mean. The specification is confusing in defining the term on page 9, lines 22-25. The specification states that "The term synthetic (s)Vpr...illustrates those peptides ...which comprises the authentic amino acid sequencederived from the molecular virus isolates HIV-1_{NL4-3}." It is not clear if "illustrates" indicates that the (s) term means the peptides from strain NL4-3, or that the NL4-3 peptides are an illustrative example of an (s) peptide. Therefore it is not clear if the claims are drawn to any synthetic peptide containing the recited regions of Vpr, or if the claims are drawn

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only to the peptides with the specific sequence from strain NL4-3. If the latter is intended, then the invention would be better described in the claim by reciting a SEQ ID number.

Claim 32 is also indefinite in reciting "at least approximately 15 amino acids". A fourteen-amino acid peptide is approximately 15 amino acids but not at least 15 amino acids. Is a 14-mer included or excluded from the claim?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

~~(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.~~

Claims 31-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by de Rocquigny et al (Journal of Biological Chemistry 272:(49):30753-9, 1997). Note that Figure 1 shows that the synthetic Vpr and (1-51)Vpr fragment both comprise a sequence identical to the sVpr¹⁻²⁰ set forth on applicant's page 15, lines 14-17, thereby clearly meeting the limitations of claims 31 and 32 and 33.

Claim 32 is rejected under 35 U.S.C. 102(e) as being anticipated by Terman 6340461.

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Table 8, at column 34, discloses at least one 14-mer peptide that is identical to a fragment of applicant's sequence recited on page 14, lines 10-16 (see peptide Vpra 55-68 in Table 8). Since 14 amino acids is "about 15 amino acids", the reference clearly anticipates the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

February 26, 2002



MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1800

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